IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Attorney Docket No. AUS920010007US1

IN RE APPLICATION OF: §	
§	
Robert E. Allen et al §	Examiner: **Ojo O. Oyebisi**
§	
Serial No. **09/773,190** §	Art Unit: **3628**
§	
Filed: **January 31,2001** §	
§	
For: **Transaction Status** §	
Messaging §	

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Brief is submitted in triplicate in support of the Appeal in

the above-identified application.

CERTIFICATE OF MAILING
37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First-Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on the date below:

December 7, 2005   *Robert V. Wilder*

_____   _____
Date   Signature

44
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46

Serial Number 09/773,190
Attorney Docket No. AUS920010007US1

REAL PARTY IN INTEREST

The present application is assigned to International Business Machines Corporation, the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no related Appeals or Interferences currently pending.

STATUS OF THE CLAIMS

Claims 1-28 are pending and stand finally rejected by the Examiner as noted in the Final Office Action mailed July 7, 2005.

STATUS OF AMENDMENTS

Prior to the Final Office Action (mailed 7/7/05), there was only one substantive Office Action mailed 7/20/2004 and one substantive Amendment mailed 10/19/2004. The Second and Final Office Action cited four new references, Potter (5,787,402), Burrus (4,716,523), Harrington (6,161,099) and Davis (6,041,314) for the first time and rejected claims 1-28 under 35 USC 103(a) as being unpatentable over various combinations of the newly cited references. More specifically, claims 1-7, 9, 13-19, 21 and 23-28 were rejected under 35 USC 103(a) as being unpatentable

119 over Potter in view of Burrus, claims 8 and 20 were rejected

120 under 35 USC 103(a) as being unpatentable over Potter in view of

121 Burrus and in still further view of Harrington, and claims 10-12

122 and 22-24 were rejected under 35 USC 103(a) as being unpatentable

123 over Potter in view of Burrus and in still further view of

124 Davis. The last entered substantive amendment was submitted

125 10/19/2004 which amended the claims to the text shown in the

126 Appendix.

127

128   .

129   ## SUMMARY OF THE INVENTION

130

131 The present application discloses a method and implementing

132 computer system in which a client is able to initiate an ongoing

133 electronic transaction between a communication device (403 Figure

134 4)and a network site 401 Figure 4). A separate port (Port C

135 Figure 4) is established for the subsequent direct transmission

136 of transaction status messages from the network site 401 back to

137 the user device 403. The client is enabled (325 Figure 3) to

138 customize a signaling system (323 Figure 3) at the user terminal

139 to designate various signals to correspond to different kinds of

140 the transaction status messages such that the client is signaled

141 (611 Figure 6) directly when a transaction status change occurs

142 (605 Figure 6) with respect to the electronic transaction

143 initiated by the client.

144

145 The above methodology is set forth in pending claim 1, which

146 recites:

147

148 "1. A method for processing electronic transactions, said method comprising:

149

150 receiving input by a server terminal from a client device over a first communication port to initiate

151 an electronic transaction, said electronic transaction requiring a subsequent communication of an

152 occurrence of a subsequent event from said server terminal to said client device;

153

154 establishing a second communication port on said client device for directly coupling said server

155 terminal to said client device;

156

157 disconnecting said server terminal from said client device;

158

159 re-connecting said server terminal to said client device through said second communication port

160 by said server terminal upon an occurrence of said subsequent event; and

161

162 transferring said subsequent communication information regarding said electronic transaction

163 subsequent event from said server terminal to said client device over said second communication

164 port..

165

166   <u>ISSUES</u>

167

168 1. Is the Examiner's rejection of claims 1-7, 9, 13-19, 21 and

169 23-28 under 35 USC 103(a) as being unpatentable over Potter in

170 view of Burrus well founded?

171

172 2. Is the Examiner's rejection of claims 8 and 20 under 35 USC

173 103(a) as being unpatentable over Potter, in view of Burrus and
174 in still further view of Harrington well founded?

175

176 3. Is the Examiner's rejection of claims 10-12 and 22-24 as being
177 unpatentable under 35 USC 103(a) over Potter, in view of Burrus
178 and in still further view of Davis well founded?

179

180

181 <u>GROUPING OF THE CLAIMS</u>

182

183 For purposes of this Appeal, claims 1-28 stand or fall together.

184

185

186 <u>ARGUMENT</u>

187

188 I. With regard to the rejection of claims 1-7, 9, 13-19, 21 and
189 23-28 under 35 USC 103(a) as being unpatentable over Potter in
190 view of Burrus, it is submitted that there is no suggestion in
191 either reference for the proposed combination and even the
192 proposed combination fails to suggest several of the claimed
193 features.

194

195 All of the independent claims, i.e. claims 1, 13, 25, 26 and 28,
196 are included in the group of claims that was rejected under 35
197 USC 103(a) as being anticipated by the newly cited Potter and
198 Burrus references. Potter discloses a system for performing a
199 financial transaction in which a bank program prompts a user for
200 input and automatically assembles an offer response to the
201 customer based on a number of different parameters. If the

202 customer delays for too long in accepting the offer, the bank
203 program automatically withdraws the offer and updates the offer
204 to avoid a "stale" conversion rate. Potter does not disclose
205 "receiving input by a server terminal over a first port",
206 "establishing a second communication port on said client device
207 for directly coupling said server and said client device",
208 "disconnecting..", "reconnecting ..." and "transferring a
209 subsequent communication over a second communication port", as
210 those recitations are clearly set forth in the independent claims
211 1, 13, 25, 26 and 28. In the exemplary embodiment illustrated in
212 the application, after a user places a bid in an auction, a
213 second port is established for directly coupling said server and
214 said client device. Nothing even similar is shown or suggested by
215 Potter. Next in the example, the user is disconnected but is
216 alerted and advised directly when the user's entered bid is no
217 longer a winning bid (i.e. another bidder had entered a higher
218 bid). Nothing even similar is shown or suggested by Potter. Next,
219 the user is allowed to re-enter the auction site to place a new
220 bid before the auction is completed. Nothing even similar is
221 shown or suggested by Potter. The process disclosed and claimed
222 by the applicant is accomplished through code on the server which
223 is effective, in connection with the bidding process, to
224 establish or initialize a new direct alert port (separate from
225 the port being used for the initial registration) between the
226 auction site and the user terminal for the transmission of
227 messages from the auction site server to the user terminal. The
228 server code compares the user's bid with subsequent received
229 bids, and when the user's bid is no longer winning, the server
230 sends a message to the user terminal over the assigned separate
231 port to sound the user-selected audio alert scenario. When the

232 user hears the alert, the user knows that the user's bid is no
233 longer winning. At that time the user may return to the auction
234 site to enter a new bid. There is not even a suggestion in Potter
235 that a second port be established for subsequent communication,
236 and that the client-server link be disconnected, and that,
237 subsequent thereto, a second communication link be established by
238 the server through the second port for communicating the
239 occurrence of a subsequent event, i.e. the change of status of
240 the entered bid. The disconnect-reconnect sequence of the present
241 invention is a necessary claimed element of the present invention
242 but is not suggested anywhere in the Potter reference. Further,
243 there is no section of the Potter patent even referenced by the
244 Examiner in the Final Office Action to correspond, *inter alia*, to
245 the claimed establishment of a second port, and then the
246 disconnect and reconnect sequence as claimed by the applicant.
247 The establishment of a second port is required to enable the
248 server to reconnect to the client upon the occurrence of a
249 subsequent higher bid. In Potter, if the customer delays too long
250 in accepting an offer from a bank, the offer is withdrawn (not
251 disconnected) and updated using the same port. This "withdrawal"
252 is cited by the Examiner on page 2 of the Final Office Action as
253 being equivalent to the disconnect-reconnect feature of the
254 present invention. Clearly this is neither stated nor intended by
255 Potter. Potter maintains a single port and merely changes offer
256 terms and conditions. There is no disconnection or re-connection
257 or establishment of a second port specifically assigned to
258 communicate information from the server to the customer upon the
259 occurrence of an event happening after the client has
260 disconnected.
261

262   Burrus is cited to show a dual mode data transfer controller with

263   numerous communication ports. The Examiner alleges that *"since*

264   *Burrus ports can be configured to support different mode (sic) of*

265   *operations, one of ordinary skill in the art would have modified*

266   *the device of Potter to include a dual mode data transfer*

267   *controller with two ports configured to receive data on one and*

268   *transmit data on another to speed up the delivery rate of*

269   *transaction messages to a user device"*. There is no referenced

270   language or suggestion in the Burrus patent or any other

271   reference for the Examiner's "conclusion" as stated above.

272   Further, there is no reason, either explicitly stated or even

273   suggested in Burrus or Potter that would prompt one to combine

274   the two references for any purpose. Further, even a forced

275   insertion of the Burrus dual mode data transfer controller into

276   the Potter system (a combination for which there is no suggestion

277   in either reference) would render the Potter system inoperable

278   for its intended purpose and still fall short of rendering the

279   present invention obvious since there would still be no

280   establishing of a second port for subsequent server-initiated

281   communication from a server to a client as is clearly set forth

282   in applicant's independent claims 1, 13, 25, 26 and 28. It is

283   noted that applicant's establishment of a second port is for the

284   purpose of enabling a subsequent re-connection from the server to

285   the client whereas the use of dual mode data transfer controller

286   in Burrus is for the purpose of eliminating time delays in

287   overall memory access throughput - two entirely different

288   purposes cannot suggest a combination. Thus it is submitted that

289   claims 1, 13, 25, 26 and 28 are allowable under 35 USC 103(a)

290   over Potter even in view of Burrus. Further, since the remaining

291   claims of the group rejected under 35 USC 103(a) over Potter in

292   view of Burrus, i.e. claims 2-7, 9, 14-19, 21, 23-24 and 27,

293   include the limitations described above which are not even

294   suggested by either Potter or Burrus, it is submitted that all of

295   the claims of the first group, i.e. claims 1-7, 9, 13-19, 21 and

296   23-28 are allowable under 35 USC 103(a) over Potter in view of

297   Burrus.

298

299   **II.** With regard to the rejection of claims 8 and 20 under 35 USC

300   103(a) as being unpatentable over Potter, in view of Burrus and

301   in still further view of Harrington, it is submitted that there

302   is no suggestion in any of the references for the proposed

303   combination and even the proposed combination fails to suggest

304   several of the claimed features. It is noted that Harrington

305   discloses a process and apparatus for conducting auctions over

306   electronic networks but, like Potter and Burrus, does not

307   disclose, or even suggest, the establishment of a second port for

308   subsequent incoming server communications, and then the client

309   disconnect and server reconnect sequence and the sending of

310   server information over the newly established second

311   communication port as disclosed and claimed by the applicant.

312   Further, claims 8 and 20 are dependent claims and include all of

313   the limitations of claims 1 and 13 which have hereinbefore been

314   distinguished from the Potter and Burrus references. Thus, even a

315   hypothetical combination of Potter, Burrus and Harrington fails

316   to suggest the combination claimed by the applicant in claims 8

317   and 20 and therefore it is submitted that claims 8 and 20 are

318   allowable under 35 USC 103(a) over Potter in view of Burrus and

319   in still further view of Harrington.

320

321

322 **III.** With regard to the rejection of claims 10-12 and 22-24 as
323 being unpatentable under 35 USC 103(a) over Potter, in view of
324 Burrus and in still further view of Davis, it is submitted that
325 the hypothetical combination of Potter, Burrus and Davis cannot
326 render claims 10-12 and 22-24 obvious under 35 USC 103(a) since
327 there is no suggestion in any of the three references for the
328 proposed combination, and even the proposed hypothetical
329 combination fails to suggest several of the claimed features,
330 including, *inter alia*, the establishment of a second port for
331 subsequent incoming server communications, and then the client
332 disconnect and server reconnect sequence and the sending of
333 server information over the newly established second
334 communication port as disclosed and claimed by the applicant.
335 Further, claims 10-12 and 22-24 are dependent claims and include
336 all of the limitations of claims 1 and 13 which have hereinbefore
337 been distinguished from the Potter and Burrus references. Thus,
338 even a hypothetical combination of Potter, Burrus and Davis
339 (which was cited merely to show a portable wireless unit) fails
340 to suggest the combination claimed by the applicant in claims 10-
341 12 and 22-24 and therefore it is submitted that claims 10-12 and
342 22-24 are allowable under 35 USC 103(a) over Potter in view of
343 Burrus and in still further view of Davis.
344
345
346 <u>CONCLUSION</u>
347
348 For the reasons stated above, applicant urges the Board to
349 conclude that the rejection of claims 1-7, 9, 13-19, 21 and 23-28
350 under 35 USC 103(a) as being unpatentable over Potter in view of
351 Burrus, and the rejection of claims 8 and 20 under 35 USC 103(a)

352 as being unpatentable over Potter in view of Burrus and in still
353 further view of Harrington, and the rejection of claims 10-12 and
354 22-24 under 35 USC 103(a) as being unpatentable over Potter in
355 view of Burrus and in still further view of Davis, are not well-
356 founded and should be reversed.

357

358 Please charge IBM Corporation Deposit Account No. 09-0447 in the
359 amount of $500.00 for submission of a Brief in Support of Appeal.
360 No additional fee or extension of time is believed to be
361 required; however, in the event an additional fee or extension of
362 time is required, please charge the fee, as well as any other fee
363 necessary to further the prosecution of this application, to the
364 above-identified deposit account.

365

366 Respectfully submitted,
367

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369
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APPENDIX

377   1. A method for processing electronic transactions, said method

378   comprising:

379

380   receiving input by a server terminal from a client device over a

381   first communication port to initiate an electronic transaction,

382   said electronic transaction requiring a subsequent communication

383   of an occurrence of a subsequent event from said server terminal

384   to said client device;

385

386   establishing a second communication port on said client device

387   for directly coupling said server terminal to said client device;

388

389   disconnecting said server terminal from said client device;

390

391   re-connecting said server terminal to said client device through

392   said second communication port by said server terminal upon an

393   occurrence of said subsequent event; and

394

395   transferring said subsequent communication regarding said

396   subsequent event from said server terminal to said client device

397   over said second communication port.

398

399   2. The method as set forth in claim 1 and further including:

400

401   detecting receipt of said transaction information by said client

402   device; and

403

404   providing an audio effect by said client device upon detection of

405 receipt of said transaction information.

406

407 3. The method as set forth in claim 2 wherein said audio effect

408 comprises an alert signal effective to alert a client that said

409 transaction information has been received, said client device

410 further including client input means arranged for enabling a

411 client to select characteristics of said audio effect.

412

413 4. The method as set forth in claim 3 wherein said input means is

414 effective to enable said client to select one or more tones as

415 said alert signal.

416

417 5. The method as set forth in claim 3 wherein said input means is

418 effective to enable said client to select a predetermined voice

419 message as said alert signal.

420

421 6. The method as set forth in claim 5 wherein, in addition to

422 said predetermined voice message, said input means is effective

423 to enable said client to select from a number of audio signals to

424 comprise said alert signal.

425

426 7. The method as set forth in claim 1 wherein said electronic

427 transaction comprises a purchase of an item by a client using

428 said client device.

429

430 8. The method as set forth in claim 1 wherein said electronic

431 transaction comprises an auction transaction wherein bids for an

432 item being auctioned are sent by said client device and received

433 by said server terminal, said server terminal being operable for:

434

435   receiving bids for said item by said server terminal;

436

437   determining when a previously received bid is no longer a winning

438   bid; and

439

440   sending notice that said previously received bid is no longer a

441   winning bid, said notice comprising said transaction information

442   sent over said second communication port.

443

444   9. The method as set forth in claim 1 wherein said client device

445   is a computer system connected to said server terminal.

446

447   10. The method as set forth in claim 1 wherein said client device

448   is a wireless device.

449

450   11. The method as set forth in claim 10 wherein said wireless

451   device is a cellular device.

452

453   12. The method as set forth in claim 10 wherein said wireless

454   device is a portable device.

455

456   13. A system for processing electronic transactions, said system

457   comprising:

458

459   a server terminal;

460

461   a client device; and

462

463   means arranged for selectively connecting said client device to

464   said server terminal, said server terminal being selectively

465 operable for:

466

467 receiving input by said server terminal from said client device
468 over a first communication port to initiate an electronic
469 transaction, said electronic transaction requiring a subsequent
470 communication of an occurrence of a subsequent event from said
471 server terminal to said client device;

472

473 establishing a second communication port on said client device
474 for directly coupling said server terminal to said client device;

475

476 disconnecting said server terminal from said client device;

477

478 re-connecting said server terminal to said client device through
479 said second communication port by said server terminal upon an
480 occurrence of said subsequent event; and

481

482 transferring said subsequent communication regarding said
483 subsequent event from said server terminal to said client device
484 over said second communication port.

485

486 14. The system as set forth in claim 13 wherein said client
487 device is selectively operable for:

488

489 detecting receipt of said transaction information from said
490 server terminal; and

491

492 providing an audio effect upon detection of receipt of said
493 transaction information.

494

495 15. The system as set forth in claim 14 wherein said audio effect
496 comprises an alert signal effective to alert a client that said
497 transaction information has been received, said client device
498 further including client input means arranged for enabling a
499 client to select characteristics of said audio effect.
500
501 16. The system as set forth in claim 15 wherein said input means
502 is effective to enable said client to select one or more tones as
503 said alert signal.
504
505 17. The system as set forth in claim 15 wherein said input means
506 is effective to enable said client to select a predetermined
507 voice message as said alert signal.
508
509 18. The system as set forth in claim 17 wherein, in addition to
510 said predetermined voice message, said input means is effective
511 to enable said client to select from a number of audio signals to
512 comprise said alert signal.
513
514 19. The system as set forth in claim 13 wherein said electronic
515 transaction comprises a purchase of an item by a client using
516 said client device.
517
518 20. The system as set forth in claim 13 wherein said electronic
519 transaction comprises an auction transaction wherein bids for an
520 item being auctioned are sent by said client device and received
521 by said server terminal, said server terminal being operable for:
522
523 receiving bids for said item by said server terminal;
524

525   determining when a previously received bid is no longer a winning
526   bid; and
527
528   sending notice that said previously received bid is no longer a
529   winning bid, said notice comprising said transaction information
530   sent over said second communication port.
531
532   21. The system as set forth in claim 13 wherein said client
533   device is a computer system connected to said server terminal.
534
535   22. The system as set forth in claim 13 wherein said client
536   device is a wireless device.
537
538   23. The system as set forth in claim 22 wherein said wireless
539   device is a cellular device.
540
541   24. The system as set forth in claim 22 wherein said wireless
542   device is a portable device.
543
544   25. A server terminal arranged for processing electronic
545   transactions, said server terminal comprising:
546
547   means for receiving input from a client device over a first
548   communication port to initiate an electronic transaction, said
549   electronic transaction requiring a subsequent communication of an
550   occurrence of a subsequent event from said server terminal to
551   said client device;
552
553   means for establishing a second communication port on said client
554   device for directly coupling said server terminal to said client

555   device;

556

557   means for disconnecting said server terminal from said client

558   device;

559

560   means for re-connecting said server terminal to said client

561   device through said second communication port by said server

562   terminal upon an occurrence of said subsequent event; and

563

564   means for transferring said subsequent communication regarding

565   said subsequent event from said server terminal to said client

566   device over said second communication port.

567

568   26. A client device for participating in an electronic

569   transaction, said client device comprising:

570

571   input means selectively operable for inputting client-related

572   transaction information relevant to said electronic transaction;

573

574   means for transmitting said client-related transaction

575   information to a server terminal over a first port, said server

576   terminal being operable in response to said client-related

577   transaction information for establishing a second port

578   selectively operable for sending server-related transaction

579   information to said client device;

580

581   means for disconnecting said server terminal from said client

582   device;

583

584   means for re-connecting said server terminal to said client

585   device through said second port by said server terminal for

586   sending server-related transaction information to said client

587   device; and

588

589   means for selectively receiving said server-related transaction

590   information from said server terminal over said second port.

591

592   27. The client device as set forth in claim 26 and further

593   including audio means operable to produce an audio effect in

594   response to receipt of said server-related transaction

595   information.

596
597   28. A storage medium including machine readable coded indicia,

598   said machine readable coded indicia being selectively operable

599   when executed within a computer system for accomplishing the

600   steps of:

601

602   receiving input by a server terminal from a client device over a

603   first communication port to initiate an electronic transaction,

604   said electronic transaction requiring a subsequent communication

605   of an occurrence of a subsequent event from said server terminal

606   to said client device;

607

608   establishing a second communication port on said client device

609   for directly coupling said server terminal to said client device;

610

611   disconnecting said server terminal from said client device;

612
613   re-connecting said server terminal to said client device through

614   said second communication port by said server terminal upon an

615 occurrence of said subsequent event; and

616

617 transferring said subsequent communication regarding said

618 subsequent event from said server terminal to said client device

619 over said second communication port.

620

621